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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,259	08/13/2001	Kaoru Watanabe	Q65822	4313

7590 09/24/2003

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EXAMINER	
SAGER, MARK ALAN	

ART UNIT	PAPER NUMBER
3714	3

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/927,259	Watanabe et al
Examiner	**Art Unit**
Sager	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Aug 13, 2001*.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-7* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☑ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim Rejections - 35 USC § 112

2. Claim 1-3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1-3 provides for the use of game machine by language 'for use in a game machine', but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1-3 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 1-3 is rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (6110041) or, in the alternative, under 35 U.S.C. 102(e) as obvious over Walker ('041). The language 'for use in a game machine... variable display device' is preamble that fails to breath life and meaning into the claims since it is not 'essential to point out the invention defined by the claim'. *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Further, the language does not limit the structure of the claimed device. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). Finally, the language recites an intended use of structure where the claim body does not depend on the preamble for completeness such that the structural limitations stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). In this instance, the cited language either is not essential to point out the invention defied by the claim as exemplified by body of claim or the language recites an intended use where the claim body does not depend on preamble for completeness such that

the structural limitations stand alone (supra) or does not further limit the structure. Walker discloses a system having a game machine with a display device for adapting gaming devices to play preferences (2:13-49, 3:28-9:26, esp. 4:38-5:41, 7:10-8:22, figs. 1-11b) teaching an indicator (346, 362), a recording medium having recorded therein a plurality of display content information items which can be displayed on the indicator (6:44-7:16, refs. 210, 216), a display content selector which selects display contents to be displayed by manual operation (6:44-7:16, 7:47-8:39, figs. 2-5, 7, 9-10b, refs. 210, 216, 362, 364, 370), a display control device, which reads out from the recording medium, display content information corresponding to the display content selected by the display content selector, and which displays the display contents on the indicator on the basis of the display content information (6:39-7:16, 7:47-8:39, figs. 2-5, 7, 9-10b, refs. 210, 216, 310, 320, , 332, 334, 336, 364, 370), wherein the display content selector is located at a position where a player, who plays a game by using the game machine, can actuate the display content selector (210, 216, 320, 362, 364, 370) and wherein the display content selector has a user operation prevention device for preventing actuation by a user of the game machine (5:25-26, 37-41). In general, Walker includes a display device 'for use in a game machine... stopped' (fig. 1-5, 7, 9-10b) when a player selects a game type which 'provides a bonus game... stopped'. Applicants' background admission of prior art (1:18-3:5) is evidence of a slot machine being of a game type with a plurality of reels each having a plurality symbols acting to serve as variable display devices where the reels are stopped by way of actuation of stop buttons where the slot machine provides a bonus to a player when a predetermined winning combination of symbols is achieved along any one of the winning lines of the variable display device when variable displays

of the variable display device are stopped. Walker's preference selection permits player selection of a game type that enables/disables 'provides a bonus to a player when a predetermined winning combination of symbols is achieved along any one of the winning lines of the variable display device when variable displays of the variable display device are stopped' as selected by the player for a game type.

Alternatively, where the preamble language breaths life and meaning into the claim (which the examiner maintains the language does not breath life and meaning into the claim), Walker's game type lacks 'provides a bonus... stopped'. The Applicants' background admission of prior art (supra) is evidence of a slot machine being of a game type with a plurality of reels each having a plurality symbols acting to serve as variable display devices where the reels are stopped by way of actuation of stop buttons where the slot machine provides a bonus to a player when a predetermined winning combination of symbols is achieved along any one of the winning lines of the variable display device when variable displays of the variable display device are stopped being known at a time prior to invention. Some players enjoy playing a game machine that provides a bonus due to opportunity to win a larger payout which in turn increases casino revenue due to players increased play in attempting to win the larger payout. Therefore it would have been obvious to an artisan at a time prior to the invention to add provides a bonus to a player when a predetermined winning combination of symbols is achieved along any one of the winning lines of the variable display device when variable displays of the variable display device are stopped as admitted prior art to Walker's game so as to provide players the opportunity to win a larger

payout in a game type having a bonus which in turn increases casino revenue due to players increased play in attempting to win the larger payout.

7. Claim 1-2 is rejected 35 U.S.C. 102(e) as being anticipated by Walker et al (6186893) or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Walker et al (6186893). Analogously, where the preamble language fails to breath life and meaning into the claim (supra), Walker ('893) discloses a system having a game machine with a display device for providing notices or messages for selective actuation on gaming device based on player preference to provide a service (2:19-38, 2:61-6:15, esp. 5:68-18, 6:6-8, figs. 1-7) teaching an indicator (22), a recording medium having recorded therein a plurality of display content information items which can be displayed on the indicator (2:19-26, 3:12-5:18, 6:6-8), a display content selector which selects display contents to be displayed by manual operation (6:6-8), a display control device, which reads out from the recording medium, display content information corresponding to the display content selected by the display content selector, and which displays the display contents on the indicator on the basis of the display content information (5:6-6:15, figs. 1-7), wherein the display content selector is located at a position where a player, who plays a game by using the game machine, can actuate the display content selector (4:50-53, 6:6-8).

Alternatively, where the preamble language breaths life and meaning into the claim (which the examiner maintains the language does not breath life and meaning into the claim), Walker's slot machine lacks 'provides a bonus... stopped'. The Applicants' background admission of prior art (supra) is evidence of a slot machine with a plurality of reels each having a plurality symbols acting to serve as variable display devices where the reels are stopped by way of actuation of stop

buttons where the slot machine provides a bonus to a player when a predetermined winning combination of symbols is achieved along any one of the winning lines of the variable display device when variable displays of the variable display device are stopped being known at a time prior to invention. Some players enjoy playing a slot machine that provides a bonus due to opportunity to win a larger payout which in turn increases casino revenue due to players increased play in attempting to win the larger payout. Therefore it would have been obvious to an artisan at a time prior to the invention to add provides a bonus to a player when a predetermined winning combination of symbols is achieved along any one of the winning lines of the variable display device when variable displays of the variable display device are stopped as admitted prior art to Walker's slot machine so as to provide players the opportunity to win a larger payout which in turn increases casino revenue due to players increased play in attempting to win the larger payout.

8. Claim 4-7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al ('041) in view of Okada (4508345) or claim 4-6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al ('893) in view of Okada (4508345). Walker ('041 or '893) each discloses a slot machine or game device comprising claimed features (supra) except a variable display stop device which stops variable display of the variable display device (clm 4) wherein the variable display stop device is actuated by a player (clm 5). Applicant's background admission of prior art (1:18-3:5) is evidence of a slot machine being of a game with a variable display stop device which stops variable display of the variable display device wherein the variable display stop device is actuated by a player to provide a skill stop actuator for player's selective input to use skill to stop spin (virtual or reel) of variable display. Further, Okada discloses a slot machine with

a bonus feature having a skill stop teaching variable display stop device which stops variable display of the variable display device wherein the variable display stop device is actuated by a player so as to provide a skill stop actuator for player's selective input to use skill to stop spin of variable display. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a variable display stop device which stops variable display of the variable display device wherein the variable display stop device is actuated by a player as admitted prior art by Applicant or as taught by Okada to Walker's game machine so as to provide a skill stop actuator for player's selective input to use skill to stop spin (virtual or reel) of variable display.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. S. Tom Hughes, can be reached on (703) 308-1806. The fax phone number for this Group is (703) 872-9303. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

M. Sager
Primary Examiner
Sep. 11, 2003